

REMARKS

Claims 1-27 are currently pending. Claims 19-27 have been allowed. Claims 7-10 were objected to. New Claims 28-30 have been added. Claims 15 and 18 have been cancelled.

Applicant would like to thank the Examiner for the telephone interview of January 28, 2004 in which Applicant's proposed amendment was discussed and the Examiner indicated that the amended and new claims appeared to be allowable over the prior art of record.

Claim 18 was objected to as being identical to claim 17. Applicant has cancelled independent claim 18.

Claim 15 was rejected under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 6,048,282 issued to Prevost. Applicant has cancelled claim 15.

Claims 1, 2, 4, 5, 11, 15 and 16 were rejected under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 6,551,689 issued to Prevost. Applicant has cancelled claim 15 and amended claims 1 and 16 to overcome this rejection. Applicant has amended independent claims 1 and 16 to recite that the first lower layer of particulate fill material consists essentially of gravel. This feature is not disclosed, taught or suggested in the prior art of record.

Claims 3 and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,551,689 issued to Prevost. Applicant respectfully traverses the rejection for the following reasons.

Applicant has amended independent claim 1 to recite that the first lower layer of particulate fill material consists essentially of gravel. This feature is not disclosed, taught or suggested in the prior art of record.

Second, the Examiner has not established a prima facie case of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument. *Id.* If examination at the initial stage does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984); W. L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983); and In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999).

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Prevost reference to include a first lower layer of particulate fill material consisting essentially of gravel. Without such a teaching, suggestion or inference in Prevost, the rejection is improper.

The obviousness rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the above § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. In re Pye & Peterson, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. In re Rinehart, 189 USPQ 143 (CCPA 1976); In re Regel, 188 USPQ 136 (CCPA 1975); In re Avery, 186 USPQ 161 (CCPA 1975); In re Imperato, 179 USPQ 730 (CCPA 1973); and In re Andre, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. W.L. Gore, 220 USPQ at 312 (Fed. Cir. 1983).

Claims 12-14, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Prevost in view of U.S. Patent No. 6,295,756 issued to Bergevin.

Applicant respectfully traverses the rejection for the following reasons.

Applicant has amended independent claim 12 to recite that the first lower layer of particulate fill material consists essentially of gravel. This feature is not disclosed, taught or suggested in the prior art of record.

Second, the Examiner has not established a prima facie case of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument. *Id.* If examination at the initial stage does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984); W. L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983); and In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999).

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Prevost reference to make a first lower layer of particulate fill material essentially of gravel. Without such a teaching, suggestion or inference in Prevost, the combination of references used the Examiner is improper.

The combination of the these references is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the above § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. In re Pye & Peterson, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. In re Rinehart, 189 USPQ 143 (CCPA 1976); In re Regel, 188 USPQ 136 (CCPA 1975); In re Avery, 186 USPQ 161 (CCPA 1975); In re Imperato, 179 USPQ 730 (CCPA 1973); and In re Andre, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. W.L. Gore, 220 USPQ at 312 (Fed. Cir. 1983).

In view of the foregoing remarks given herein, applicant respectfully believes this case is in condition for allowance and respectfully requests allowance of the amended and new claims. If the Examiner believes any detailed language of the claims requires

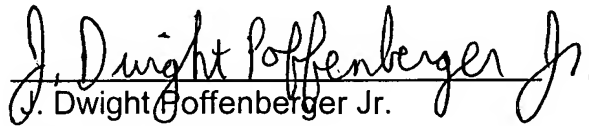
Application No. 10/634,217
Amdt. dated January 28, 2004
Reply to Office Action of December 18, 2003

further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicant is of the opinion that an additional fee of \$95 is due. Enclosed is a check for \$95. If any additional charges or credits are necessary to complete this communication, please apply them to deposit account no. 23-3000.

Respectfully submitted,

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